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Date: March 11, 2009

By /Kurt G. Briscoe/
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Attorney Docket No. 101769-315

Confirmation No. 4883

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : HUSEMANN, et al.
SERIAL NO. : 10/539,792
CUSTOMER NO. : 27384
FILED : May 9, 2006
FOR : TRANSPARENT ACRYLATE ADHESIVE MASS COMPRISING A FILLER
ART UNIT : 1796
EXAMINER : Karuna P. Reddy

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

Applicant respectfully requests pre-appeal brief review of the final rejection mailed on September 11, 2008, specifically, the three obviousness rejections based on Schmidt et al. ("Schmidt"), US 5,910,522, alone or in view of Husemann, US 6,958,186, or Knovel, Critical Tables — Publication 2003.

Applicant respectfully submits that the Examiner has committed the following errors:

1. The Examiner errs in failing to recognize that while the instant claims are drawn to “transparent acrylate *pressure-sensitive adhesive*,” Schmidt is not drawn to a pressure-sensitive adhesive.

Main claim 1, from which all of the other rejected claims depend, expressly states that the invention claimed is “[a] transparent acrylate pressure-sensitive adhesive comprising” the indicated components. This statement, although it appears in the preamble of the claim, is not a mere statement of intended use that can be ignored. It is, rather, a statement of structure, specifying a type of adhesive and, thus, implicitly requiring specific ingredients and resulting properties, as is well known to persons having ordinary skill in the art.

Wikipedia defines a “pressure-sensitive adhesive” as an “adhesive which forms a bond when pressure is applied to marry the adhesive with the adherend.” Wikipedia also points out that “[n]o solvent, water, *or heat* is needed to activate the adhesive.”

The Examiner completely ignores this limitation, describing Schmidt in all occurrences as “disclosing *an* adhesive,” and nowhere even alleging that Schmidt describes pressure-sensitive adhesives.

Further, Applicants respectfully submit that it would be immediately apparent to anyone skilled in the art that Schmidt’s materials are not pressure-sensitive adhesives, but, rather, hardening adhesives, i.e., they are activated by applying the adhesive to parts to be joined, joining the parts and then curing the adhesive, for instance, thermally. See, for example, Schmidt’s claims 13 and 14.

The rejections of the instant claims as being obvious over Schmidt alone or as evidenced by Knovel are clearly in error as the Examiner has not dealt with all claim limitations.

2. The Examiner errs in finding Schmidt renders *prima facie* obvious filler particles comprising a coating of a polyacrylate chemically bonded to a free radical initiator, which initiator is, in turn, chemically bonded to silicate and/or silica gel.

The Examiner concedes in the very last paragraph on page 3 of the final rejection that:

“Schmidt is *silent* with respect to coating of filler (i.e., silicate and/or silica gel) with polyacrylate that is chemically bonded to a free-radical initiator which free radical initiator is chemically bonded to silicate and/or silica gel.”

However, the Examiner finds at the end of the first paragraph on page 4 that:

“[I]t would have been obvious to one skilled in the art to recognize that during [Schmidt’s] mixing process thermal initiators comprising functional groups would interact to some degree with functional groups on both silica particles and surface modifying substances such as acrylic acid, methacrylic acid and methyl methacrylate, and that the surface modifying compounds would in fact polymerize during thermal curing process to form a coating of polyacrylate on the surface of silicate and/or silica gel containing chemically attached thermal initiators.”

Applicants respectfully submit that this is complete conjecture, unsupported by anything on the present record.

Just as important, there is no mention anywhere in this statement of the free-radical initiator, which, according to the current claims, must be bonded between the polyacrylate coating and the silicate and/or silica gel.

However, before addressing the inherency deficiency in more detail, Applicants respectfully submit that before even getting to this point, a person having ordinary skill in the art must make a number of selections within Schmidt’s disclosure, and the Examiner has not pointed to anything that would have led persons skilled in the art to make the selections necessary to arrive at the mixture that would have to be thermally cured in order to achieve, according to the Examiner’s theory, the instant constructs.

First, persons skilled in the art would have to choose polyacrylates as the base adhesive. Although Schmidt mentions polyacrylates at column 3, line 42, polyacrylates are one of a large number of listed polymers.

Second, such persons would have to select silicate and/or silica gel as the fillers. Schmidt mentions silicates at column 4, line 6, but once again as a part of a large list of inorganic polymers.

Third, such persons would have to select small-sized silicates. Schmidt teaches at column 4, lines 36-38, that the particles usually have a size of 1 to 200 nm, which is too big a

range to meet the claim requirement of “not more than 50 nm.” Although Schmidt teaches a preferred and particularly preferred range of “to 50 nm” and “to 20 nm,” respectively, these are further selections that would need to be made.

Fourth, such persons would have to select the size of the silicates so that after the Examiner’s inherency theory is carried out there results polyacrylate-initiator-silicate and/or silica gel particulates no more than 50 nm in size.

Fifth, such persons would need to select a free-radical initiator. Again, such materials are within Schmidt’s broad teachings.

Sixth, once such selections were made, such persons would need to carry out a thermal curing under conditions that inherently yield polyacrylate chemically bonded to initiator chemically bonded to silicate and/or silica gel, again, with the size restrictions discussed above.

Finally, such persons would need to do all this in the context of preparing a pressure-sensitive adhesive, a requirement that, as noted above, the Examiner has not dealt with at all.

Respectfully, there is nothing in Schmidt directing persons skilled in the art to make all of these selections. Even if such selections *could* be made, Applicants point out that such possibility does not make out a *prima facie* case of obviousness. See, *In re Baird*, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (“The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.”) Instead, a *prima facie* case of obviousness is only made out if the prior art highlighted the selections that must be made to achieve the claimed compounds in some manner, and, therefore, led persons skilled in the art towards them. The Examiner makes absolutely no case how the prior art highlights the pertinent selections and, thus, leads persons skilled in the art to the instant compounds. In the absence of such effort, the Examiner has failed to make out a *prima facie* case of obviousness.

3. The Examiner errs in finding that filler particles comprising a coating of a polyacrylate chemically bonded to a free radical initiator, which initiator is, in turn, chemically bonded to silicate and/or silica gel would inherently form during Schmidt’s thermal curing process.

Further, Applicants point out that the concept of inherency is strictly applied generally, and misapplied by the Examiner in this case. Where, as here, the Examiner relies on a theory of

inherency as to any particular element, then the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by probabilities or possibilities, and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference. *Id.*

From page 8 of the instant application, one can glean some exemplary steps to make an azo-initiator-functionalized silyl compound. Even this falls short of the current claims, wherein the azo-initiator is required to be further chemically bonded to a polyacrylate coating. The Examiner says that such a complex series of chemical reactions leading to the instant constructs can occur *in situ* through thermal curing, but gives no sound technical reasoning why this is the case. As *Robertson* makes clear, the burden is squarely on the Examiner to provide a sound technical reasoning why it will *necessarily* be the case that even if the appropriate selections within Schmidt's disclosure are made, the necessary result of thermal curing will be particles comprising a coating of polyacrylate chemically bonded to initiator chemically bonded to silicate and/or silicate gel, wherein the particles additionally are not more than 50 nm in size.

The Examiner says in the third paragraph on page 8 that this is "implicit." However, not only does Schmidt not imply this, but the standard is "inherent" and this must necessarily occur. The Examiner has not shown this to occur necessarily.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the final rejections and allowance of claims 1-6, 9-12, 14-17, 19 and 20.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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